

REMARKS

In this paper, claim 38 is amended. After entry of the above amendment, claims 1-61, 63-65 and 67-74 are pending, and claims 62 and 66 have been canceled.

Support for the amendment to claim 38 may be found in Figs. 2 and 44. Fig. 44 shows that the second portion of the guide surface is formed by an elongated protuberance (98i) that extends towards the cable support (44) as shown in Fig. 2, and Fig. 2 shows the cable supported on and by the elongated protuberance.

Claims 37-60 and 69-74 were rejected under 35 U.S.C. §251 as being improperly broadened by attempting to recapture previously surrendered subject matter. This basis for rejection is respectfully traversed.

The office action relies on the well-known Clements case to reject the claims for recapture. As noted previously, *Clement* is a typical recapture case wherein a limiting feature was added to an existing element, and then that limiting feature was deleted in the reissue proceeding. More specifically, original claim 1 in the Clement patent was directed to a method for treating waste paper that removes “stickies,” such as glues and plastics, under a first set of environmental conditions, before removing inks under a second set of environmental conditions. The original claim recited, *inter alia*, (a) forming an aqueous pulp of said material at low temperature and low specific mechanical energy; (b) separating non-ink contaminants by mechanical separation; (c) softening ink particles by submitting the pulp to high temperature, high shear forces, and at least one de-inking agent under alkaline conditions; and (d) detaching the ink particles by submitting the pulp to high temperature, high shear forces, and at least one chemical dispersing agent under alkaline conditions. During prosecution, these steps were amended, *inter alia*, by limiting step (a) to room temperature and a mechanical energy of lower than 50 KW.H/Ton; by limiting step (b) to room temperature; and by limiting steps (c) and (d) to a temperature between 85° and 130° C, mechanical energy more than 50 KW.H/Ton, and strong alkaline conditions having a pH of at least 9. In the reissue application, the narrowing features were canceled while retaining the corresponding steps. The Court held that

the deletion of the added features constituted an impermissible recapture of previously surrendered subject matter.

The applicant relies on the *Meyers* case to support the amendments. In *Meyers*, the claims were directed to features of a night vision system. Each original claim included a pulsing circuit for a light-emitting diode (LED). During prosecution, the patentee distinguished over the prior art by amended the pulsing circuit to add two limitations: (1) that the circuit would pulse on and off at intervals that resulted in the LED being off more often than on; and (2) that the pulsing circuit, when on, would pulse at a substantially higher level of power than it would be able to sustain if left on continuously. The pulsing circuit, including the two added features, was deleted from the claims. The Court held that deletion of the pulsing circuit, together with the two features added to the pulsing circuit to distinguish over the prior art, did not constitute impermissible recapture.

These two cases can be understood by the following analogy: If a claim recites $A + B + C$ and is amended during prosecution to recite $A + B + C + C'$, wherein C' is a feature of element C , then C' cannot be deleted in a reissue proceeding. That is the *Clement* case. However, if a claim recites $A + B + C$ and is amended during prosecution to recite $A + B + C + C'$, wherein C' is a feature of element C , then the claim may be amended in a reissue proceeding to delete C and C' and recite $A + B + D$, wherein feature D is a narrowing feature independent of element C . That is the *Meyers* case. The patentee in the *Meyers* case was not attempting to recapture protection of $A + B + C$, but was attempting to protect an independent invention $A + B + D$.

The present application is similar to *Meyers* in that the original claims recited “first and second cam members”, i.e., element “C.” During prosecution of the original patent, the first and second cam members were amended to include their respective input and output designations as well as the movement and camming surface features. The added features collectively can be called feature C' . If the preliminary amendment merely deleted the input and output designations as well as the movement and camming surface features and otherwise kept the two cam members, then the examiner would be correct that *Clement* prevents such an amendment.

However, there is a difference between deleting a limiting *feature* that was added to an element versus deleting the element itself. *Clement* applies to the former, whereas *Meyers* applies to the latter. In other words, the preliminary amendment in this case canceled not just feature C', but element C (the two cams) as well. The actuating arm (equivalent to "element D") was added to protect an invention that is independent of an invention that involves the cams.

Claims 37-45, 47-53 and 69-74 were rejected under 35 U.S.C. §103(a) as being unpatentable over Le Deit, et al (US 5,647,475) in view of Carre, et al (US 4,582,177) and Huang (US 6,148,964). This basis for rejection is respectfully traversed.

The office action states on page 9 that the recesses along slot (56) for accommodating screw (60) makes the cable support not adjustable in any direction, or at any time relative to the caliper housing. First, the recesses along slot (56) only prevent rotational adjustment of the cable support (44). Nothing prevents adjustment of cable support (44) in the direction of the rotational axis. In other words, screw (60) could be loosened or removed and washers or shims placed beneath cable support (44), thereby adjusting the position of cable support (44) upwardly from the page.

It appears that the position taken in the office action is that that once screw (60) is tightened, cable support (44) no longer is adjustable in any direction as recited in claim 37, it is not adjustable at any time as recited in claim 72, and it is not removable as recited in claim 73. It is respectfully submitted that such interpretations cannot be made. The suffix "-able" means "having capability." In *Dorel Juvenile Group, Inc. v. Graco Children's Products, Inc.*, 429 F.3d 1043, 77 USPQ.2d 1090 (Fed.Cir. 2005), the Court of Appeals for the Federal Circuit held that the definition of "removably attached" and "removably secured" means "designed at some time or another to come apart." In fact, the Court expressly rejected the argument that two parts screwed together are not "removably attached" to each other. The applicant adopts the Court's rationale that "removable" means "designed at some time or another to come apart," and "adjustable" means "designed at some time or another to be adjusted." Thus, it cannot be maintained that the Le Deit cable support is not adjustable or removable simply because it is screwed together.

Claim 38 has been amended to clarify that the cable is supported on and by the protuberance. Neither Le Deit, Carre, et al nor Huang disclose or suggest a circumferentially *elongated* protuberance that points in a rotational direction of the actuating arm towards the cable support where the cable passes through the cable support so that the cable is supported on and by the protuberance as recited in amended claim 38. A protuberance is defined for the purpose of the claims as a structure that bulges out beyond the surrounding surface, and such is not the case in the cited references.

As for claim 69, one piece means one piece. One piece does not mean two pieces bolted together, nor is such an interpretation reasonable.

Claim 46 was rejected under 35 U.S.C. §103(a) as being unpatentable over Le Deit, et al in view of Carre, et al, Huang and Mott (US 5,201,402). This basis for rejection is respectfully traversed for the same reasons noted above.

Claims 55-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Le Deit, et al in view of Carre, et al, Huang and Isai (US 5,960,914). This basis for rejection is respectfully traversed for the same reasons noted above.

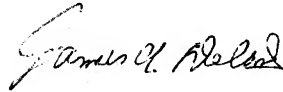
Claim 60 was rejected under 35 U.S.C. §103(a) as being unpatentable over Le Deit, et al in view of Carre, et al, Huang, Isai and Mott. This basis for rejection is respectfully traversed for the same reasons noted above.

Accordingly, it is believed that the rejections under 35 U.S.C. §103 and §251 have been overcome by the foregoing amendment and remarks, and it is submitted that the claims are in condition for allowance. Reconsideration of this application as amended is respectfully requested. Allowance of all claims is earnestly solicited.

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Application No.: 10/826,173
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PATENT

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James A. Deland". The signature is written in a cursive, flowing style.

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